

REMARKS

Claims 1-30 were pending in this application.

Claims 1-9, 11-19, and 21-29 have been rejected.

Claims 10, 20, and 30 have been allowed.

No claims have been amended.

Claims 1-30 remain pending in this application.

Reconsideration and full allowance of Claims 1-30 are respectfully requested.

I. ALLOWABLE CLAIMS

The Applicants thank the Examiner for the indication that Claims 10, 20, and 30 are allowable. The Applicants have not amended Claims 10, 20, and 30. As a result, these claims remain in condition for allowance.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-2, 5-9, 11-12, 15-19, 21-22, and 25-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,260,024 to Shkedy (“*Shkedy*”) in view of U.S. Patent No. 5,987,422 to Buzsaki (“*Buzsaki*”). The Office Action rejects Claims 3-4, 13-14, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Shkedy* and *Buzsaki* in view of U.S. Patent No. 6,073,109 to Flores (“*Flores*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of

establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. MPEP § 2142.

Shkedy recites systems and methods for creating binding contracts in a buyer-driven system. (*Abstract*). Orders from individual buyers may be combined into a single collective purchase requirement, and sellers willing to bid on the purchase requirement are located. (*Abstract*). A central controller manages the operation of the system. (*Abstract*).

The Office Action acknowledges that *Shkedy* fails to disclose “executing a workflow upon receiving a message.” (*Office Action, Page 3, Third paragraph*). In effect, the Office Action is acknowledging that *Shkedy* fails to disclose “creating a first work flow record used to control a first work flow associated with a first service request,” where the first work flow is “at least partially developed or executed” by “receiving, storing and transferring” at least one of “messages, data files, software and documents” as recited in Claims 1, 11, and 21.

The Office Action then asserts that *Buzsaki* discloses these elements of the claims and that it would be obvious to modify *Shkedy* with the recitations of *Buzsaki*. (*Office Action, Page 3, Third paragraph*). The Applicants respectfully traverse these assertions.

Buzsaki recites a method for executing a workflow that requires input from a role. (*Abstract*). The workflow is executed until an operation requiring input from a role is detected. (*Abstract*). A request for input is communicated to the role, and the workflow continues once the input from the role is received. (*Abstract*).

The Office Action asserts that it would be obvious to modify *Shkedy* with the recitations of *Buzsaki* “so that an input from a role is solicited and processed in a smooth and efficient manner.” (*Office Action, Page 3, Third paragraph*). However, *Shkedy* lacks any mention of

using workflows that require input from roles. In fact, *Shkedy* fails to mention using any type of workflows, and the Office Action has not provided any motivation or suggestion as to why one skilled in the art would modify *Shkedy* to include the use of workflows. In other words, while the Office Action asserts that using *Buzsaki* allows “input from a role” to be solicited and processed “in a smooth and efficient manner” for a workflow, the Office Action fails to establish that this functionality is needed or even desired in the system of *Shkedy*. Without that showing, the Office Action cannot establish that a person skilled in the art would modify *Shkedy* with the recitations of *Buzsaki* as asserted in the Office Action.

Moreover, *Buzsaki* specifically recites that workflows often represent processes used in modern businesses. (*Col. 1, Lines 12-14*). While *Shkedy* indicates that the sellers and the buyers using its system may be businesses (*Col. 10, Lines 11-14; Col. 28, Lines 1-4*), *Shkedy* and *Buzsaki* provide no suggestion or motivation for communicating workflows used by a business to the central controller of *Shkedy*. Based on this, there is no suggestion or motivation in either reference for allowing the central controller of *Shkedy* to process the workflows of *Buzsaki*. As a result, the Office Action has not established that a person skilled in the art would modify the central controller of *Shkedy* to create and use a “work flow record” to control a “first work flow” that is “at least partially developed or executed” as recited in Claims 1, 11, and 21.

For these reasons, the Office Action has not shown that a person skilled in the art would be motivated to combine *Shkedy* and *Buzsaki* as asserted in the Office Action. As a result, the Office Action has not established a *prima facie* case of obviousness against Claims 1, 11, and 21. Accordingly, the Applicants respectfully request withdrawal of the § 103 rejections and full

allowance of Claims 1-9, 11-19, and 21-29.

III. CONCLUSION

As a result of the foregoing, the Applicants assert that the remaining claims in the application are in condition for allowance and respectfully request full allowance of such claims.

SUMMARY


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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